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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/293,486	04/15/1999	WARREN M. FABEL	6391-1-3	4928
23334 7590 08/21/2007 FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/293,486

Applicant(s)

FABEL, WARREN M.

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-21 and 23-32 is/are allowed.
- 6) ☐ Claim(s) 33-40 is/are rejected.
- 7) ☐ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/23/2000.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 recites the limitation "the backing sheet" in the second to last line.

There is insufficient antecedent basis for this limitation in the claim.

Claims 34 – 40 are further rejected since they are dependent from Claim 33.

Claim Objections

Claim 22 is objected to because of the following informalities: The "F" in the word "First" in line 2 should not be capitalized. Appropriate correction is required.

Claim 39 is objected to because of the following informalities: The last word "sheet" of Claim 39 should be replaced with "section" since the first sheet is not mentioned to have a label removably attached. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Walz (U.S. 4,682,793).

In regards to Claim 33, Walz discloses a special service mailing assembly for mailing an article requiring a special service, the assembly comprising: a first sheet 16;

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a second sheet 20 (Column 3, Lines 66 – 67) directly attached to the first sheet (Column 4, Lines 1 – 19; 16 and 20 can be coated and 22 is unnecessary), having a first section integrally formed with a second section, the first section including a label 79 having an adhesive 93 back side indicative of the special services (Column 8, Lines 1 – 7, 40 – 42; Figure 6, item 79; Figure 7, item 93); and the second section including a form 91 and square to the right, a first anchor portion having an adhesive back side (Figure 6, Item 93 is behind the square) and a second anchor portion having an adhesive back side (Column 4, Lines 46 – 49; the opposite edge can have adhesive and therefore a second anchor portion which would be opposite the first) wherein the anchor portions are located at opposite ends of the form, the form being independently detachable from the anchor portions and the label (the form 91 can be detached along the tear lines), and further wherein the sheet is removably attached to the backing sheet 18 (Column 3, Lines 66 – 67; Figure 1, Item 18) by the adhesive back sides of the label (through carrier strip 94), the first anchor portion and the second anchor portion (Column 4, Lines 46 – 49 said the sheets can be attached by adhesive on both edges).

In regards to Claim 34, as applied to Claim 33, Walz further discloses a line of separation (Examiner considers 80 and 36 as one line) formed between the form and label and the line of separation constructed and arranged to provide independent removal of the form (Column 8, Lines 10 – 11; Figure 6, Items 36, 79, 80).

In regards to Claim 35 as applied to Claim 33, Walz further discloses a first tear (36 and 80 are considered one line) line formed between the first anchor portion of the form and a second tear 78 line formed between the second anchor portion and the form

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(Column 8, Lines 10 – 11; Figure 6, items 36, 78, 80), the first and second tear lines constructed and arranged to provide independent detachment of the form.

In regards to Claim 37, as applied to Claim 33, Walz further discloses the label 79 is a certified mail label (Figure 6, Item 79).

In regards to Claim 38, as applied to Claim 33, Walz further discloses wherein the first sheet includes printer feed 34 holes located along opposite sides of the first sheet (Column 4, Lines 59 – 64, Item 34).

In regards to Claim 39, as applied to Claim 33, Walz further discloses at least one identifier section 82 having identifier related to the special service label removably attached to the first sheet (Column 8, Lines 10 – 20; Figure 6, Item 82; Considering it is a receipt, the type of service will be identified with at least the reference number 44).

In regards to Claim 40, as applied to Claim 33, Walz further discloses at least one identifier section 82 having identifier related to the special service label removably attached to at least one of the anchor portions [label exists in the anchor portion but also is removed from it and there is a gap in the portion] (Column 8, Lines 10 – 20; Figure 6, Item 82; Considering it is a receipt, the type of service will be identified with at least the reference number 44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walz.

In regards to Claim 36 Walz discloses a receipt indicia on a substrate in receipt area 82 (Column 8, Lines 10 – 15). A return receipt postcard is merely a substrate with return receipt indicia. Walz discloses the claimed invention except for the specific arrangement and/or content of indicia (return receipt indicia on a particular portion) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the form 91 having the ability to contain indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (receipt information on 82) and the substrate (form 91) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Allowable Subject Matter

Claims 1 – 32 are allowed upon correction of the objections. Claim 1 is independent with Claims 2 – 13 being dependent; Claim 14 is independent with Claims 15 – 21 being dependent; Claim 22 is independent; Claim 23 is independent; with 24 – 32 being dependent.

In regards to Claim 1, the prior art does not disclose alone or in combination of a mailing form comprising first and second superimposed sheets wherein the second sheet having predetermined, non-adhered areas on its inner face which are aligned with the detachable areas of the first sheet, the non-adhered areas being covered with a non- adhesive coating on the inner face facing said first sheet; at least one portion of said form including one of said adhered areas being detachable from the remainder of the form to provide a predetermined mailing form part, each of the sheets having predetermined printed indicia on its outer face in said one adhered portion; the inner face of the first sheet being coated with a layer of adhesive material for securing the first sheet to the second sheet, the adhesive layer in said detachable areas comprising said adhesive backing; and the form having at least one tear line for detaching said one portion of the form from the remainder of the form, said portion including a pair of second tear lines extending perpendicular to said one tear line for detaching a part of said mailing form part from the remainder of said portion, and side strips on opposite sides of said portion outside said tear lines, the inner face of said second sheet being coated with non-adhesive material in said side strips.

In regards to Claim 14, the prior art does not disclose alone or in combination of a mailing form comprising first and second superimposed sheets wherein the inner face of the second sheet being coated with a non-adhesive material in predetermined coated areas of said inner face whereby the first sheet is adhered to the second sheet only in adhered areas outside said coated areas; the sheets having tear lines extending through both sheets whereby sections of the form can be separated from one another; the first sheet having tear lines extending through only the first sheet around predetermined non-adhered areas of the first sheet whereby said non-adhered areas can be detached from the remainder of the form, said non-adhered areas including labels for attaching to an item to be mailed; at least one of said separable form sections including an adhered area and comprising a predetermined mailing form part, each of said sheets having printed indicia on its outer face at least in said one form section; the form having a first tear line for detaching a portion of the form from the remainder of the form, said portion including said predetermined mailing form part and an additional part, said portion including at least three tear lines extending transverse to said first tear line, including a second tear line for detaching said additional part from said mailing form part, and a pair of tear lines for defining a central portion between said tear lines and side strips on opposite sides of said central portion outside said tear lines, the inner face of said second sheet being coated with non-adhesive material in said side strips.

In regards to Claim 22, the prior art does not disclose alone or in combination of a mailing form comprising first and second superimposed sheets wherein a layer of adhesive material coating the entire inner face of the first sheet; the first sheet having a

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plurality of detachable, non-adhered areas which are detachable from the remainder of the first sheet; the first and second sheets being permanently secured together on predetermined, adhered areas of the form; the second sheet having predetermined, non-adhered areas on its inner face which are aligned with said detachable areas of the first sheet, the non-adhered areas being covered with a non-adhesive coating, whereby the first sheet is permanently adhered to the second sheet only in areas outside said non-adhered areas; the first sheet having printed indicia on its outer face defining at least two separate form parts and a separation region between form parts extending across the entire sheet between opposite edges of said sheet; one of said form parts including a mailing form portion for attachment to an item to be mailed, the mailing form portion including a central, return postcard and side strips on opposite sides of the central postcard, and having a pair of tear lines extending transverse to said separation region for separating each side strip from said return postcard; and the inner face of said second sheet being coated with non-adhesive material in said side.

In regards to Claim 23, the prior art does not disclose alone or in combination of a special service mailing assembly with a sheet having first and second sections wherein the sheet is removably attached to the backing sheet by the adhesive back sides of the label, the first anchor portion and the second anchor portion; and a cut out section in the backing sheet.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
August 6, 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER